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| ART UNIT | PAPER NUMBER |
| | 23 |

DATE MAILED:
3208

Below is a communication from the EXAMINER in charge of this application

07/26/95

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☒ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☐ Applicant's response to the final rejection, filed 7-12-95 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

- a. ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require new search and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: In claim 1, the contact face not necessarily being at a right angle to the support part is sine qua non. See also claim 2 & 3. At least one movable arm in claim 12 is a new issue. The amendments to the spec. would require a substitute spec.

2. ☐ Newly proposed or amended claims the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: _____
Claims objected to: _____
Claims rejected: 1-14

However;

- ☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because it is not commensurate in scope with the claims. That is, the percentage of contact of the jaw contact faces has not been clarified.
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other _____

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Art Unit: 3206

Part III DETAILED ACTION

Preliminary Matters

1. In the supplemental amendment filed 12 June 1995 by fax, Applicant refers to re-writing claims 1-14 and inserting new claims 15-18. It is noted, however, that only claims 1-11 have been re-written and that there were no new claims inserted. Claims 1-11 as presented in the 12 June 1995 amendment and claims 12-14 as presented in the 22 May 1995 amendment are the subject of this office action.

Drawings

2. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the several beams connected end-to-end in a row by couplers of claim 11 must be shown or the feature cancelled from the claim. No new matter should be entered.

Specification

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use

Art Unit: 3206

the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention.

Specifically, reference is made to "a support with a circular section or not" (emphasis added). Applicant has not sufficiently described a support part which is "not" circular, nor has Applicant described how the movable arms 2 would be able to be "turned into several directions around said support" if the support was "not" circular in section.

Claim Rejections - 35 USC § 112

4. Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

5. Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, step "a", the phrase "with a section circular or not" is vague and indefinite. Further, in the next to last line of step "c", "the thickness" lacks proper antecedent basis.

In claim 2, lines 10 and 12, "said buffer" lacks proper antecedent basis.

Art Unit: 3206

In claim 3, improper use of brackets to identify deleted subject matter on lines 2 and 3 leads to confusing claim language. Also, "said at least one substantially elastic buffer" at line 2 lacks proper antecedent basis (see also claim 8).

In claim 4, it is not clear what is meant by the insertion at line 1 "for overlapping". Similar confusion is seen at lines 1 and 2 of claim 5 for "for being used as a helping hand" and at claim 6, lines 1 and 2 "for being used as a horizontal helping hand".

The last line of claim 6 is not clear ("other successive arm of same pair").

In claim 7, "said two arms that are movable" lack proper antecedent basis.

Additionally, in claim 12, lines 5, 6 and 8, "said arm" and "said buffer" lack proper antecedent basis. It is not clear what is meant by "any resistant surface" in step a.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3 and 10-12 are rejected under 35 U.S.C. § 103 as being unpatentable over Neff in view of Thornton.

Neff teaches a device for clamping objects comprising a cylindrical support 10 on which is mounted a first arm 12 and a

Art Unit: 3206

second arm 14,16. The arms can slide along the support and are able to rotate thereabout. Neff, however, does not teach fitting the arms with elastic buffers at their ends.

Thornton teaches fitting the arms of a clamp structure with rubber clamping pads at their ends.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the clamping arms of Neff with elastic pads, in light of the teachings of Thornton, in order to protect the object being clamped. Note that the contact faces of Neff are at right angles to the support part and that the pads taught by Thornton can be considered rings which cover the end of each arm.

Regarding claim 10, the arms of Neff are manually moved into contact with the object being held and are then released so as to lock each of the arms by tilting them against the support part. Note that the support part of Neff can be considered to be made of several beams connected together by couplers as claimed in claim 11.

8. Claims 4-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Neff in view of Thornton as applied to claims 1-3 and 10-12 above, and further in view of the EPO 0080960 patent to Berna.

Neff in view of Thornton teach the invention except for additional sets of movable arms placed on the support part.

Art Unit: 3206

Berna, in figure 3 of the EPO patent, teaches providing a support part of a clamping device with multiple sets of movable arms.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the support part of Neff/Thornton with additional movable arms, in light of the teachings of Berna, in order to be able to hold more than one object at a time. Note that one of ordinary skill would be fully capable of adding additional sets (more than two) of movable arms to the support part, depending on the number of objects being held.

9. Claim 7 is rejected under 35 U.S.C. § 103 as being unpatentable over Neff in view of Thornton as applied to claims 1-3 and 10-12 above, and further in view of Ditto.

Neff in view of Thornton teach the invention except for an end of the support part being fitted with a removable stop.

Ditto teaches providing a support part in a clamp with an end cap 32.

It would have been obvious to one of ordinary skill in the art, at the time of invention, to provide the support part of Neff/Thornton with an end cap, in light of the teachings of Ditto, in order to protect the users hand. Note that the end cap of Ditto can function as a stop and is removable from the support part.

Art Unit: 3206

Allowable Subject Matter

10. Claims 8, 9, 13 and 14 would be allowable for the reasons of record if rewritten to overcome the rejections under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Response to Amendment

11. Applicant's arguments filed 22 May 1995 have been fully considered but they are not deemed to be persuasive.

Regarding the 35 U.S.C. §112 first paragraph remarks, the Examiner maintains that the examples a-c cited by Applicant in no way describe a support part that does not have a circular section. Further, the example of a stirrup forming a loop is not understood and in no way gives support for the arms being able to be turned about the support when the support is not circular in section. Regarding the support part made of several beams connected end-to-end, the Examiner stands corrected in that the specification, as originally filed, does provide support for this limitation. However, in order for Applicant to be able to claim this feature, this feature must be shown in the drawings in accordance with paragraph 2 above.

Regarding the 35 U.S.C. §112 second paragraph rejections, it is noted that some of the problems have been addressed by Applicant in the recent amendment of 12 June 1995. However, many

Art Unit: 3206

35 U.S.C. §112 second paragraph problems resulted from the amendment and remain in the claims as cited in paragraph 5 above.

Regarding the remarks concerning the 35 U.S.C. §103 rejections, It is not the Examiner's intention to replace the arms of Applicant's invention with the arms of Neff. Applicant's arguments here are not understood. Regarding the several beams connected together, Applicant has provided no reasoning why several beams connected together would function better than one beam or support part as taught by the references. Regarding the arguments directed to the buffers, Applicant provides no reasoning why "ring buffers" are better than the buffers disclosed by Thornton. Thornton clearly teaches elastic buffers 54,56 that are thick enough to elastically clamp the workpiece, that act the same as Applicant's buffers and can be considered "ring buffers" as claimed. It is not clear what Applicant's argument is here.

Applicant's argument with respect to the Berna EPO 0080960 reference is very confusing and not understood by the Examiner. The Examiner maintains that the rejection of claims 4-6 is proper for the reasons of record.

Regarding the rejection of claim 7 in view of the Ditto reference, the stops of Ditto are able to be removed. Is it impossible to remove the stops 32,34 from the support parts of Ditto? The Examiner maintains that it is not impossible to

Art Unit: 3206

remove the stops, thus the stops can be considered to be removable. The limitation "so as to turn those of said two arms that are movable into removable arms" lends no patentable weight to the claimed invention.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

13. This application is subject to the provisions of Public Law 103-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8, 1995, taking into account any reference to an earlier filed application under 35 U.S.C. 120, 121 or 365(c), applicant, under 37 CFR 1.129(a), is entitled to have a first submission entered and considered on the merits if, prior to abandonment, the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a first submission and the appropriate fee of \$365.00 for a small entity under 37 CFR 1.17(r), the finality

Art Unit: 3206

of the previous Office action will be withdrawn. In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under 37 CFR 1.17(r).

Contact Information

14. Documents related to the instant application may, during prosecution within the group, be submitted to the Group 3200 facsimile center at (703) 305-3579. The faxing of such documents must conform with the notice published in the Official Gazette, 1096 OG 30 (October 19, 1988). Applicant is reminded to clearly mark any facsimile transmission as "DRAFT" if it is not to be considered as an official response.

15. Any inquiry concerning this communication should be directed to Examiner Tom Hughes at telephone number (703) 308-1806.



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sth
June 28, 1995